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| 7590 04/08/2010 MANELLI DENISON & SELTER PLLC 7th Floor 2000 M Street, N.W. Washington, DC 20036-3307 | | | EXAMINER BARQADLE, YASIN M | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/852,848

Applicant(s)

ARNESON ET AL.

Examiner

YASIN BARQADLE

Art Unit

2456

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 8 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

2. The amendment filed on September 01, 2009 has been fully considered but are not persuasive in view of the new grounds of rejection and the comments below.

- Claims 7-8 and 26-33 are presented for examination.

Response to Arguments

In response to applicant's arguments in view of the newly added limitation "message delivery format", the Examiner notes that Chack and Makela or Chack and Pepe teach the newly added limitation as shown in the detailed new office action below.

For example, the Applicant argues "Claims 7 and 8 are not obvious in view of the combined teachings of Chack and Pepe et al." page 6 of the remarks. The Examiner disagrees. Chack teaches providing a caller requested information such as URLs according the caller's capability and based on a table maintaining caller's information (profile) providing the caller the desired information (col. 7, lines 9-22). While Pepe teaches delivering a message to a subscriber based on media type and device type according to the subscriber's profile (col. 21, lines 40-52; col. 24, line 1-8 and col. 27, lines 1-8).

In response to Applicant's argument that "Makela fails to show the recited message delivery format or the advantages provided thereby, or providing the email according to the retrieval profile" page 5. The Examiner notes that in claim 7, it is not clear who formulates a user specific retrieval profile and such Makela's invention of specifying a message delivery format to a caller (col. 3, lines 27-46 and col. 8, lines 30-36) meets the argued limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chack USPN. (6751211) in view of Pepe et al USPN (5742668).

As per claim 26, and 30 Chack teaches a method of retrieving information by a first device (Fig. 3, 60) from a second device (fig. 3, 68), comprising:

formulating and storing a user specific retrieval profile designating and user specified pre-determined information relating to a call communications

device “In other embodiments of the invention, the transaction processing system identifies the telephone number or other identifier associated with a received call. Based on information known about the call initiator, the transaction processing system determines whether to automatically provide a URL to the call initiator. For example, customers of an organization operating the transaction processing system may notify the organization that they have the capability to receive and utilize a URL. The organization maintains a table of such customers based on the customer's telephone number, account number, or other identifying information. If the transaction processing system receives a call from a customer listed in the table, then the transaction processing system automatically provides a URL to the customer.” (col. 7, lines 9-22);

receiving a call from said first calling device associated with said first telephone number intended for a second device associated with a second telephone number (a telephone caller initiates a call to a telephone number associated with a transaction processing system col. 7, lines 61-63. See also col. 9, lines 43-46 and the abstract);

associating said user specified pre-designated information with the call related information of said first calling device “When the transaction processing system receives a request from a telephone caller for a URL (or otherwise determines that the caller can receive URLs), the transaction processing system may generate a custom web page for the caller having a

unique URL. That URL is provided to the caller, thereby allowing the caller to view the custom web page on the caller's computer. The custom web page may contain, for example, information regarding the caller's account balance or information regarding pricing and availability of various products of interest to the caller" (col. 7, lines 9-49); detecting at said second device a caller ID of said call from said first calling device in response to detecting said caller ID at said second device automatically retrieving said user specified pre-designated information (col. 7, lines 9-32); at said second device, terminating said call from said first calling device before answering (the transaction processing system provides a URL to the telephone caller without answering the call col. 7, lines 61-65 and col. 8, lines 61-63); and transmitting said retrieved user specified pre-designated information to said first calling device according to said retrieval profile ("The transaction processing system provides a URL to the telephone caller. The web page associated with the URL contains information requested by the caller" (col. 7, lines 9-32 and col. 7, lines 61-65; col. 8, lines 61-63 and col. 9, lines 46-48).

Regarding claims 26 and 30, although Chack shows substantial features of the claimed invention including transmitting retrieved user-specific pre-designated information (requested URLs according to caller's capability) to a telephone number as explained above, he does not explicitly show where the retrieval profile designates a message delivery format.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Chack, as evidenced by Pepe (5742668).

In analogous art, Pepe et al whose invention is about a network which provides a variety of electronic text delivery, receipt, and notification options system, disclose transmitting a desired information in a short message (notification message are delivered via PDA and/or a pager device) according to a message delivery format. See col. 5, lines 22-30 and col. 21, lines 40 to col. 22, line16]. Giving the teaching of Pepe et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Chack by employing the system of Pepe et al in order deliver a desired information to subscribers based on delivery format according to user's profile and to devices of the subscriber's choice capable of receiving short message information.

Regarding claims 27, Pepe further teaches converting, if necessary, said retrieved user specified pre-designated information to short message and transmitting said short message to said first calling device (col. 21, lines 40-52; col. 24, line 1-8 and col. 27, lines 1-8).

As per claims 28 and 32 Chack teaches a method of retrieving information by a first device from a second device, further comprising:

determining said second telephone number from call related information associated with said call to said first telephone number by said first device [col.6, 11-18 and col. 8, lines 24-32].

As per claim 29 and 33, Chack teaches a method of retrieving information by a first device from a second device, wherein: said caller related information is caller ID [col.6, 11-18 and col. 8, lines 24-32].

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makela USPN. (6301338) in view of Chack USPN. (6751211).

As per claims 7 and 8, Makela teaches the method of providing electronic mail notification to a communications device (abstract), comprising:

 associating an email with a first phone number, said email comprising said user specified pre-designated information relating to said calling communications device (col. 3, lines 27-46 and col. 8, lines 30-36); and
 using said call related information from said call to automatically identify (col. 5, lines 2-11) and provide said email to said communications device after said communications device calls a first phone number [col. 3, lines 27-46; col. 5, lines 31-36 and col. 8, lines 30-36].

Regarding claims 7 and 8, Makela shows substantial features of the claimed invention including sending SMS and/or an email message to caller's associated email address automatically (col. 3, lines 27-46 and col. 8, lines 30-36). However, Makela does not explicitly show where the message includes caller specified pre-designated information.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Makala, as evidenced by Chack.

In analogous art, Chack disclose "When the transaction processing system receives a request from a telephone caller for a URL (or otherwise determines that the caller can receive URLs), the transaction processing system may generate a custom web page for the caller having a unique URL. That URL is provided to the caller, thereby allowing the caller to view the custom web page on the caller's computer. The custom web page may contain, for example, information regarding the caller's account balance or information regarding pricing and availability of various products of interest to the caller" (col. 7, lines 40-49). Giving the teaching of Chack a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Makala by employing the system of Chack in order to provide identified calling customers immediately with information that is pertinent to their call.

Chack further teaches formulating a user specific retrieval profile designating user specified pre-determined information relating to a call

communications device “In other embodiments of the invention, the transaction processing system identifies the telephone number or other identifier associated with a received call. Based on information known about the call initiator, the transaction processing system determines whether to automatically provide a URL to the call initiator. For example, customers of an organization operating the transaction processing system may notify the organization that they have the capability to receive and utilize a URL. The organization maintains a table of such customers based on the customer's telephone number, account number, or other identifying information. If the transaction processing system receives a call from a customer listed in the table, then the transaction processing system automatically provides a URL to the customer.” (col. 7, lines 9-22).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al USPN (5742668) in view of Chack USPN. (6751211).

As per claim 7, Pepe et al teach the method of providing electronic mail notification to a communications device, comprising:

formulating a user specific retrieval profile designating a message delivery format and user specified pre-determined information for said calling communications device (col. 5, lines 33-63 and col. 19, lines 32-52. See also col. 21, lines 40 to col. 22, line 16);

associating an email with a first phone number (the number called by the subscriber) receiving a call from a communications device (subscriber portable device 32) [col. 21, 15-67]; and using call related information from said call to automatically identify [col. 6, lines 47-65 and col. 21, lines 18-67] and provide said email to said communications device after said communications device calls a first phone number [col. 7, lines 30-46 and col. 21, lines 18-67].

Although Pepe et al shows substantial features of the claimed invention including providing emails to a communication device, he does not explicitly show in response to detecting a caller ID, automatically transmitting desired information to a device before answering a call.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Pepe et al, as evidenced Chack USPN. (6751211).

In analogous art, Chack whose invention is about a method for communicating information discloses a transaction processing system that provides a desired information (a URL) to a caller in response to detecting a caller ID and before answering the call (col. 7, lines 61-65 and col. 8, lines 61-63). Giving the teaching of Chack, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Pepe's email providing system by employing the method providing information to a telephone caller without answering the call of Chack. One ordinary skill in the art would do so because the transaction processing system does not answer

the incoming call therefore no connection charges are incurred since no connection was established.

As per claim 8, Pepe et al teach the method of providing electronic mail notification to a communications device according to claim 7, further comprising:

obtaining a communications device identifier when said communications device dials said first phone number, and using said communications device identifier to select said electronic mail message [col. 14, lines 46-63 and col. 21, 40-65].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on

the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dharia Rupal can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yasin M Barqadle/
Primary Examiner, Art Unit 2456